

**RESPONSE UNDER 37 C.F.R. § 1.116
EXPEDITED PROCEDURE
EXAMINING GROUP 2800**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
First Named Inventor : Mo Xu

Appln. No.: 10/630,207

Filed : July 30, 2003

For : PERFORMANCE FLOW GUIDE FOR
IMPROVED ACOUSTICS

Docket No.: S01.12-1167/STL 11080

Group Art Unit: 2827

Examiner:

Edgardo San Martin

PRE-APPEAL BRIEF REQUEST FOR REVIEW

ELECTRONICALLY FILED OCTOBER 15, 2007

Sir:

Applicant respectfully requests a Pre-Appeal Brief Review of the rejection of claims 19 and 26 under 35 U.S.C. § 103 based on *Gidumal*, U.S. Patent No. 6,296,691 (“*Gidumal*”), since the rejection is based on clear error of fact and omission of essential elements to establish a *prima facie* rejection. Pursuant to MPEP §2143.03, to establish a *prima facie* basis to reject claims under 35 U.S.C. §103, all of the words in a claim must be considered in judging the patentability of the claim and all of the claim limitations must be taught or suggested by the prior art.

The rejection of claims 19 and 26 as set forth in the Office Action dated June 14, 2007 is not supported by *Gidumal*. The Office Action fails to establish that each of the recited claim limitations of claims 19 and 26 is taught by the prior art and accordingly fails to establish a *prima facie* basis to reject claims under 35 U.S.C. §103.

First, claim 26 is dependent on independent claim 1. Independent claim 1 recites.

A data storage device comprising:

a housing;

at least one disc rotatably mounted to the housing, wherein rotation of the at least one disc creates a fluid flow region proximate to the at least one disc;

an airflow guide that projects into the housing and comprises an elastomeric body forming a barrier surface in the fluid flow region.

Claim 26 further recites wherein the elastomeric damping material is formed of **a curable gel material**.

Claim 26 is rejected based upon the rejection of claim 1 which states that Gidumal teaches a data storage device comprising a housing (Figs. 2A and 2B, Item 19); a disc stack assembly (Figs. 2A and 2B, Item 12) rotatably mounted to the housing, wherein the rotation of the disc stack assembly creates a fluid flow region proximate to the disc stack assembly; and an airflow guide (Figs. 2A and 2B, Item 11) that projects into the housing and comprises an elastic wall in the fluid flow region of the disc stack assembly and the elastic wall having an elastic surface (Col. 6, lines 57-Col.7, line 21) but fails to establish the elastic wall is an elastomeric damping material. The quoted claim language in the rejection is not the same as the actual claim language of claim 1 and claim 26 and thus it is not clear whether the proper claim limitations were considered. In particular, it is noted that claim 1 recites an elastomeric body and not an elastic wall . . . as set forth in the rejection.

As set forth above, claim 26 recites wherein the elastomeric damping material is formed of a curable gel material. In the first paragraph of page 3 of the Office Action, the Examiner admits that Gidumal fails to disclose wherein the elastic wall is an elastomeric damping material, but states “[t]he Examiner considers that it would have been an obvious matter of design choice to employ an elastomeric damping material as the elastic wall because it is well known in the art of acoustics to employ elastomeric damping material as vibration dampers, additionally it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice”.

Although the Office Action alleges that it would be obvious to use an elastomeric damping material, the Office Action contains no allegation as to a curable gel material. Although claim 26 is rejected in the Office Action, the Office Action is silent as to support for or the basis for the rejection of claim 26 in view of the prior art. The Office Action fails to set forth a *prima facie* basis to reject claim 26 and thus, the rejection of claim 26 constitutes clear error.

Claim 19 is dependent on independent claim 9. Independent claim 9 recites.

A data storage device comprising:

a housing;

at least one disc rotatably mounted to the housing, wherein rotation of the at least one disc creates a fluid flow region proximate to the at least one disc; and

an airflow guide that projects into the housing and comprises an elastomeric body forming a barrier surface in the fluid flow region;

Claim 19 is dependent upon claim 9 and further recites wherein the elastomeric body is formed of a **curable gel-like material**.

As discussed above, in the first paragraph of page 3 of the Office Action, the Examiner admits that Gidumal fails to disclose “wherein the elastic wall is an elastomeric damping material”, but states “[t]he Examiner considers that it would have been an obvious matter of design choice to employ an elastomeric damping material as the elastic wall because it is well known in the art of acoustics to employ elastomeric damping material as vibration dampers; additionally, it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice.

In contrast in the 3rd paragraph of page 3 of the Office Action, the Office Action states that Gidumal teaches the limitations of dependent claim 19, namely wherein the elastomeric body is a curable gel-like material. Although the Examiner admits that Gidumal does not teach an airflow guide formed of an elastomeric body, the Office Action states that Gidumal teaches wherein the elastomeric body is a curable gel-like material. Other than a broad statement that Figures 1A –8 and Col. 6, line 57-col. 9, line 35 of Gidumal teach the limitations of claims 3-7 and 17-25, the Office Action contains no support for the allegation that the subject matter wherein the elastomeric body is formed of a curable gel-like material of claim 19 is taught or suggested by Gidumal. Figures 1A –8 and Col. 6, line 57-col. 9, line 35 of Gidumal referenced in the Office Action do not teach wherein the elastomeric body is formed of a curable gel-like material as claimed. Based upon the foregoing, the Office Action fails to establish a *prima facie* basis to reject claim 19 under 35 U.S.C. §103 and thus the rejection based upon Gidumal should be withdrawn.

The Director is authorized to charge any fee deficiency required by this paper or credit any overpayment to Deposit Account No. 23-1123.

Respectfully submitted,

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